

C. Remarks

In the Office Action, claims 19 and 20 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Additionally, claims 1-6, 12-15 and 17-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,894,277 to Keskin et al. ("Keskin"), and claims 7-11 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Keskin in view of U.S. Patent No. 5,701,988 to Tsukada ("Tsukada"). Applicant traverses the rejections as follows.

1. Claim Amendments

Claim 1, as amended, recites:

A retrofit electronic lock unit comprising:

 a housing structured and arranged to be retrofit to an existing key operated locker, the locker having a fixed structure, at least one door hingeably attached to the fixed structure, and at least one lock channel positioned in the fixed structure adjacent the door; and

 an electronically controlled locking mechanism enabling keyless entry into the locker;

 wherein the retrofit electronic lock unit is securable to the lock channel.

Support for this amendment may be found throughout the application as filed, such as, for example, at claim 6, at paragraph [0041] and at FIG. 4. Claim 6, the subject matter of which is now incorporated into claim 1, has been cancelled. Dependent claims 2-5 and 7-17 have been amended in consequence of the amendment to claim 1.

Independent claims 18 and 19 have been amended in manner analogous to that of claim 1.

Independent claim 19 has additionally been amended to recite a computer-readable medium having processor-executable instructions stored thereon. Dependent 20 has been amended in consequence of the amendment to claim 19.

Claims 18 and 19 have also been amended to correct an inadvertent typographical error.

2. Claim Rejections under 35 U.S.C. § 101

Claims 19 and 20, as amended, are directed to a computer readable medium having processor-executable instructions stored thereon. Clearly, the instructions stored on the computer-readable medium constitute a computer program and thus qualify as functional descriptive material. See MPEP 2106.01. A claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See MPEP § 2106.01.I. Applicant therefore submits that claims 19 and 20 constitute statutory subject matter and respectfully requests withdrawal of the § 101 rejection.

3. Claim Rejections under 35 U.S.C. § 102(b)

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See MPEP § 2131. As explained above, claim 1 has been amended to recite:

A retrofit electronic lock unit comprising:
a housing structured and arranged to be retrofit to an existing key operated locker, the locker having a fixed structure, at least one door hingeably attached to the fixed structure, and at least one lock channel positioned in the fixed structure adjacent the door; and
an electronically controlled locking mechanism enabling keyless entry into the locker;
wherein the retrofit electronic lock unit is securable to the lock channel.

Independent claims 18 and 19 have been amended in an analogous manner. Applicant submits that Keskin fails to teach or suggest each and every feature set forth in claims 1, 18 and 19. Specifically, Applicant submits that Keskin fails to teach or suggest, among other things, that “the retrofit electronic lock unit is securable to the lock channel” (claim 1) or that “the electronically controlled locking mechanism is securable to the lock channel” (claims 18 and 19).

In particular, Keskin discloses a two-piece unit that sandwiches a locker door and “has an internal locking mechanism which engages with fixed locker structure,” or “blocks the internal locking mechanism” of the locker. See Keskin at column 5, lines 20-26. All of the embodiments described in Keskin provide electronic locks positioned in or on the face of the locker door. By contrast, the retrofit electronic lock of claim 1 is securable to the lock channel. One of skill in the art would readily appreciate that lock channel recited in claim 1 is not a part of the door. In this regard, Applicant directs the Examiner’s attention to paragraph [0041] and FIG. 4 of the application as filed. Accordingly, because Keskin does not disclose a retrofit electronic lock unit “wherein the retrofit electronic lock unit is securable to the lock channel,” Applicant submits that Keskin does not teach each and every claim limitation recited in claim 1. For analogous

reasons, Applicant submits that Keskin does not teach each and every claim limitation recited in claims 18 and 19.

Moreover, Applicant submits that there is no motivation to modify Keskin to include such a feature. If the electronic lock in Keskin were so modified it would necessarily change its principle of operation. In particular, the electronic lock disclosed by Keskin is design to mount to a locker door across the thickness of the door with electrical connection established through plugs that mate through a hole in the door. The electronic lock disclosed by Keskin is further designed such that the latch engages the fixed structure of the locker. See Keskin at FIG. 5. Accordingly, modifying Keskin such that it is securable to a lock channel and capable of engaging a locker door from the channel would necessarily change the operation described in Keskin and would require substantial re-engineering and redesign. In this regard, Applicant notes that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. Similarly, Applicant notes that where a suggested modification or combination of references would require a substantial reconstruction and redesign of the elements shown in the primary reference or change in basic principle under which the primary reference construction was designed to operate, then the reference cannot render the claims *prima facie* obvious. See MPEP § 2143.01.

Applicant therefore submits that independent claims 1, 18 and 19, as amended, are not anticipated or rendered obvious by Keskin. Applicant further submits that claims

2-6, 12-15, 17 and 20 are also not anticipated or rendered obvious by Keskin by virtue of their dependence from claims 1, 18 and 19, and by their own merits.

4. Claim Rejections under 35 U.S.C. § 103(a)

Applicant respectfully submits that Tsukuda fails to remedy the above-described defect of Keskin with respect claims 1, 18 and 19. Accordingly, Applicant submits that dependent claims 7-11 and 16 are not rendered obvious by the cited combination of Keskin and Tsukuda. See MPEP § 2143.03 (where an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious).

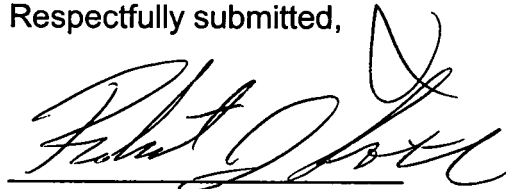
Applicant does not concede the correctness of the rejections with respect to any of the dependent claims in the application and hereby reserves the right to make additional arguments as may be necessary because additional features of the claims further distinguish the claims from the cited references, taken alone or in combination.

D. Conclusion

Applicant respectfully requests a Notice of Allowance for the pending claims in the present application. If the Examiner is of the opinion that the present application is in condition for disposition other than allowance, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below in order that the Examiner's concerns may be expeditiously addressed.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 11-1110.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robert J. Toth', is written over a horizontal line.

Robert J. Toth
Reg. No. 57,741
Agent for Applicant

Kirkpatrick and Lockhart Preston Gates Ellis, LLP
Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, Pennsylvania 15222
Tel. (412) 355-8382
Fax (412) 355-6501